



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,262	04/19/2000	Jerry Dunietz	03797.87364	4106

28319 7590 10/07/2003

BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET, N.W.
ELEVENTH STREET
WASHINGTON, DC 20001-4597

EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 10/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/552,262

Applicant(s)

DUNIETZ ET AL.

Examiner

Peter J Smith

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: application filed on 04/19/2000, IDS filed on 12/05/2001 and 06/25/2003.
2. Claims 1-35 are pending in the case. Claims 1, 10, 12, 14, 16, 19, 24, and 32 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 16-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Murashita, US 6,330,574 filed 03/30/1998.**

Regarding independent claim 16 and dependent claim 18, Murashita discloses locating a tag within a document associated with a portion of content in col. 3 lines 17-19 and Fig. 3. Murashita discloses identifying a pre-defined integer alias for the tag in col. 3 lines 19-22 and in Fig. 3. Murashita also discloses replacing the tag with the alias in col. 3 lines 22-24 and in Fig. 3.

Regarding dependent claim 17, Murashita discloses locating an attribute type with a tag in col. 3 lines 17-19. Murashita discloses identifying a pre-defined attribute alias for the attribute

Art Unit: 2176

type in col. 3 lines 19-22. Murashita also discloses replacing the attribute type with the attribute alias in col. 3 lines 22-24.

Regarding independent claim 19, Murashita discloses at least one tag having encoded therein a predefined integer alias for a tag in col. 3 lines 17-22. Murashita discloses a content portion associated with a tag in col. 3 lines 12-17. Murashita also discloses a code separating a tag from a content portion in col. 3 lines 22-24.

Regarding dependent claim 21, Murashita discloses at least one pre-defined attribute type alias in col. 3 lines 12-24.

5. Claims 24-31 are rejected under 35 U.S.C. 102(a) as being anticipated by “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999.

Regarding independent claim 24, Open eBook discloses a root directory and a content subdirectory having nested therein on linked content file providing content information relating to the electronic book linked to the root directory in sections 2.2 and 2.3.

Regarding dependent claim 25, Open eBook discloses at least one link destination index file linked to the content file in section 2.3.

Regarding dependent claim 26, Open eBook discloses a page break index providing an index of page break corresponding to the electronic book in sections 2.3, 2.5 and 2.6.

Regarding dependent claim 27, Open eBook discloses a metadata file linked to the root directory and having information about the electronic book in sections 2.3.

Art Unit: 2176

Regarding dependent claim 28, Open eBook discloses a manifest file linked to the root directory providing a listing of the files in the content subdirectory relating to the electronic book.

Regarding dependent claim 29, Open eBook discloses using at least one Cascading Style Sheet (CSS) file in section 4.

Regarding dependent claim 30, Open eBook discloses a metadata file linked to the root directory and having information about the electronic book in sections 2.2 and 2.3.

Regarding dependent claim 31, Open eBook discloses a digital rights management database linked to the root database in sections 2 and 2.1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-7, 9, 12-13, 20, 22-23, and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murashita, US 6,330,574 filed 03/30/1998 in view of “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999.**

Regarding independent claim 1 and dependent claim 9, Murashita teaches separating a tag from content with a separation variable and replacing a tag with an alias, wherein the alias is a pre-defined representation for the tag in col. 3 lines 12-33. What Murashita does not teach is inserting at least one flag within a tag to form an encode tag structure. Open eBook teaches

Art Unit: 2176

inserting metadata information which could be at least one flag within a tag to form an encode tag structure in section 2.2 lines 7-12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to include the metadata insertion of Open eBook with the tag replacement so that the information contained in the tags allows the program to process the document more effectively and in more detail.

Regarding dependent claim 2, Murashita teaches replacing at least one attribute type within the tag with an attribute alias, wherein the attributes alias is a predefined representation for the attribute type in col. 3 lines 12-33.

Regarding dependent claim 3, Murashita does not teach UTF-8 encoding the first encoded document to form a second encoded document. Open eBook does teach UTF-8 encoding the first encoded document to form a second encoded document in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to use UTF-8 encoding taught by Open eBook to create a second document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit the file.

Regarding dependent claim 4, Murashita teaches compressing the second encoded document to form a compressed document in col. 3 lines 12-24.

Regarding dependent claim 5, Murashita does not teach inserting a position flag to indicate whether the tag is a start tag or an end tag. Open eBook teaches inserting metadata which could be a position flag and also teaches start and end tags in sections 2.2 and 3.1.5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to include a position flag in the metadata to indicate the start or end of the content so that the program can more easily process the content.

Regarding dependent claim 6, Murashita does not teach inserting a word break flag between a left and right term of associated content. Open eBook does teach inserting additional metadata to describe the content which could include inserting a word break flag between a left and right term of associated content in section 2.2 lines 7-12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the invention as claimed. It would have been obvious and desirable include word break metadata in the tag so that the word breaks could have been easily located by the program.

Regarding dependent claim 7, Murashita does not teach inserting a no search flag in association with a portion of content information. Open eBook does teach inserting additional metadata which could be inserting a no search flag in association with a portion of content information in section 2.2. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to include a no search flag metadata to enhance the performance of the program processing the document.

Regarding independent claim 12 and dependent claim 13, Murashita teaches identifying a tag within a document associated with a portion of content in the abstract. Murashita does not teach determining whether the portion is to be displayed for viewing by a reading device or if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion. Open eBook does teach determining whether the portion is to be displayed for viewing by a reading device in section 3.3 and if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion in section 2.2 lines 7-12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to have combined the display determination and metadata insertion of Open eBook into Murashita so that the parts of the document not displayed do not consume processing time of the program for certain functions.

Regarding dependent claim 20, Murashita does not teach group of flags consisting of WORDBREAK, NOSEARCH, STARTTAG, and ENDTAG. Open eBook does teach adding additional metadata to the tags which could include a group of flags consisting of WORDBREAK, NOSEARCH, STARTTAG, and ENDTAG in section 2.2 lines 7-12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to have used the metadata additions taught by Open eBook to have increased the ability of the program to manipulate the document.

Regarding dependent claim 22, Murashita does not teach UTF-8 encoding the markup language document. Open eBook does teach UTF-8 encoding markup language document in

Art Unit: 2176

section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to use UTF-8 encoding taught by Open eBook to create a second document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit the file.

Regarding dependent claim 23, Murashita teaches a compressed markup language document in the abstract.

Regarding independent claim 32 and dependent claim 35, Murashita teaches receiving a document having a first format in col. 3 lines 12-33. Murashita also teaches processing a document to encode and pre-compute a markup language with the document in the abstract and col. 3 lines 12-33. Murashita does not teach forming a converted document comprising a root directory and a content subdirectory having nested therein at least one linked content file providing content information relating to the converted document linked to the root directory. Open eBook does teach forming a converted document comprising a root directory and a content subdirectory having nested therein at least one linked content file providing content information relating to the converted document linked to the root directory in sections 2.2 and 2.3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to use the converted document taught by Open eBook to improve Murashita so that the content could be better conveyed to a reader.

Art Unit: 2176

Regarding dependent claims 33 and 34, Murashita does not teach the Open eBook format or an electronic book document. Open eBook does teach both the Open eBook format and an electronic book document in section 1.1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to have used the Open eBook format as well as an electronic book format to enhance Murashita so that the information is better conveyed to a reader.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 in view of Kucera et al. (hereafter referred to as Kucera), US 4,864,502.

Regarding independent claim 10 and dependent claim 11, Open eBook teaches identifying a tag between a left and right term within a document in sections 2.2 and 3.1.5. Open eBook also teaches inserting additional metadata into a tag, which could be a word break flag between left and right terms in section 2.2 lines 7-12. Open eBook does not explicitly teach tagging a single word. Kucera does teach tagging a single word in col. 2 lines 54-64.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Kucera into Open eBook to create the claimed invention. It would have been obvious and desirable to tag single words so that the metadata could be as descriptive as possible of the document.

Art Unit: 2176

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 in view of Edelman et al. (hereafter referred to as Edelman), US 6,442,576 B1 filed 08/06/1997.

Regarding independent claim 14 and dependent claim 15, Open eBook teaches searching a manifest file for a file referenced by a Uniform Resource Locator (URL) in section 2.3. Open eBook does not teach identifying a URL within a document or if the file is identified with a reference string, replacing the URL with the reference string. Edelman does teach identifying a URL within a document and if the file is identified with a reference string, replacing the URL with the reference string in col. 2 lines 33-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Edelman into Open eBook to create the claimed invention. It would have been obvious and desirable use the URL identification taught by Edelman and improve Open eBook so that the manifest file can be readily accessed through use of the identified URL. This would have increased the efficiency of the program processing the document.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murashita, US 6,330,574 filed 03/30/1998 in view of “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 as applied to claim 1 above, and further in view of Edelman et al. (hereafter referred to as Edelman), US 6,442,576 B1 filed 08/06/1997.

Regarding dependent claim 8, Murashita in view of Open eBook does not teach replacing a URL within the content information with a reference string. Edelman does teach replacing a URL within the content information with a reference string in col. 2 lines 33-50. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Edelman into Murashita in view of Open eBook to create the claimed invention. It would have been obvious and desirable to utilize the URL replacement taught by Edelman in Murashita in view of Open eBook so that the document can be further compressed leading to less usage of storage space and shorter file transmission times.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. W3C, "HTML 4.01 Specification – Section 7", 12/24/1999, pages 1-22 discloses the global structure of an HTML document which includes disclosures on meta data, meta element, and meta data profiles in section 7.4. DeRose et al., US 6,055,544 priority filed 03/15/1996 discloses generation of chunks of a long document for an electronic book system. DeRose et al., US 6,055,544 priority filed 11/03/1995 discloses processing electronically published documents in a first markup language into a document in a second markup language using a mapping table. Draper et al., US 6,581,062 B1 filed 03/02/2000 discloses a mapper generating a structured organization to store the collection of semi-structured data. The mapper further collaterally generates a description of how the semi-structured data are stored under the structured organization. Bodin et al., US 6,604,106 B1 filed 12/10/1998 discloses compression and delivery of web server content. Edwards et al., US 6,370,553 B1 filed 08/31/1998 discloses a

Art Unit: 2176

molecular document comprised of atomic documents located in a document management system.

The document management system separates the content of the document from the properties which are used to describe the document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

PJS

August 26, 2003



**SANJIV SHAH
PRIMARY EXAMINER**